

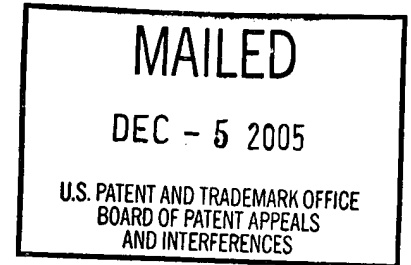
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLORIA DeCARLO MASSARO,
DONALD MASSARO, and
ROSHANTHA A. CHANDRARATNA

Application 09/919,195



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on November 3, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

A review of the file indicates that on November 15, 2004, appellants filed an Appeal Brief under the rules set forth in 37 CFR § 1.192(c). However, the rules under 37 CFR § 1.192(c) were abolished on September 13, 2004, and replaced by 37 CFR § 41.37(c), which states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

A review of the application reveals that the following sections are missing from the Appeal Brief filed November 15, 2004:

- (1) "Evidence appendix," as set forth in 37 CFR § 41.37(c)(1)(ix), and
- (2) "Related proceedings appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

Accordingly, the Appeal Brief filed on November 15, 2004 does not comply with the new rules under 37 CFR § 41.37(c). It is required that a supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>

Also, the Examiner's Answer filed on March 29, 2005 does not comply with the headings as set forth in the new rules under 37 CFR § 41.37 (x). Correction is required.

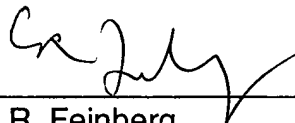
Additionally, on June 1, 2005, appellants filed a Reply Brief. There is no indication on the record that this paper was considered by the examiner.

Accordingly, it is

ORDERED that the application is returned to the examiner to:

- (1) hold the Appeal Brief filed on November 15, 2004 defective;
- (2) to notify appellants to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37;
- (3) for the examiner to consider the supplemental Appeal Brief, vacate the Examiner's Answer mailed March 29, 2005, and issue a revised Examiner's Answer in accordance with the rules effective September 13, 2004;
- (4) have a complete copy of the supplemental Appeal Brief and any subsequent Examiner's Answer scanned into the record;
- (5) consider the Reply Brief;
- (6) written notification to appellants of said consideration
- (7) to have complete copies of said consideration scanned into the IFW file; and
- (8) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES



Craig R. Feinberg
Program and Resource Administrator
(571) 272-9797

Carlos A. Fisher
Allergan, Inc.
2525 Dupont Drive
Irvine, CA 92623

dem